



PATENT
Attorney Docket No. A-70197-1
Attorney File No.: 469008-00020

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

SHIEH *et al.*

Serial No. 10/028,277

Filed: December 19, 2001

For: *Biochannel Assay for
Hybridization with Biomaterial*

Examiner: CHIN, Christopher L.

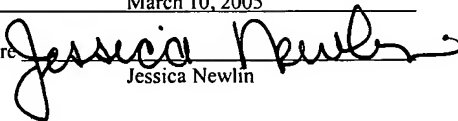
Art Unit: 1641

CERTIFICATE OF MAILING

I hereby certify that this correspondence, including listed enclosures, are being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

Date: March 10, 2005

Signature


Jessica Newlin

TERMINAL DISCLAIMER TO
OBVIATE A DOUBLE PATENTING REJECTION

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Petitioner, **Motorola, Inc.** (hereinafter "Motorola"), represents that it is the assignee of the entire right, title, and interest of:

1. The instant application, U.S. Serial No. 10/028,277, filed December 19, 2001, which is a continuation of U.S. Serial No. 09/438,600, filed November 12, 1999, now U.S. Patent No. 6,361,958; and
2. U.S. Patent No. 6,361,958, issued March 26, 2002.

An assignment is recorded in the United States Patent and Trademark Office for U.S. Serial No. 09/438,600, filed November 12, 1999, now U.S. Patent No. 6,361,958, at

Reel No. 010396, Frame No. 0535. A copy of the assignment is attached to this Terminal Disclaimer.

Motorola hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154-156 and 173, as shortened by any terminal disclaimer of Serial No. 09,438,600, now U.S. Patent No. 6,361,958.

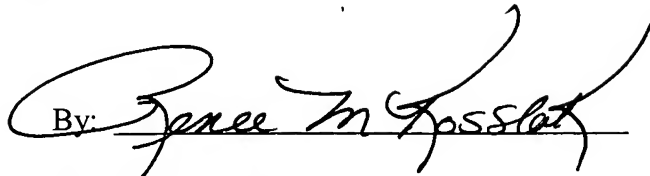
Motorola hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, Motorola does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154-156 and 173 of Serial No. 09,438,600, now U.S. Patent No. 6,361,958, as shortened by any terminal disclaimer, in the event that the patent later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer.

Serial No.: 10/028,277
Filed: December 19, 2001

The undersigned is an attorney or agent of record.

Dated: March 10, 2005

By: 

Name: Renee M. Kosslak

Telephone: (415) 781-1989

Also included herewith is the terminal disclaimer fee of \$130.00 under 37 C.F.R.

1.20(d). While Applicants believe that no other fees are due at this time, the Commissioner is authorized to charge any fees, including extension fees or any other relief that may be required, in connection with this reply to Deposit Account 50-2319 (Order No. A-70197-1/RMS/RMK/469008-20).



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

FEBRUARY 23, 2000

PTAS

MCDONNELL, BOEHNEN, HULBERT & BERGHOFF
JOHN J. MCDONNELL
300 SOUTH WACKER DRIVE - 32ND FLOOR
CHICAGO, IL 60606



101206965A

UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 11/12/1999

REEL/FRAME: 010396/0535
NUMBER OF PAGES: 6

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

SHIEH, CHAN-LONG

DOC DATE: 11/03/1999

ASSIGNOR:

FOLEY, BARBARA

DOC DATE: 11/03/1999

ASSIGNOR:

YU, HUINAN

DOC DATE: 11/03/1999

ASSIGNOR:

CHOONG, VI-EN

DOC DATE: 11/03/1999

ASSIGNEE:

MOTOROLA, INC.
1303 E. ALGONQUIN ROAD
SCHAUMBURG, ILLINOIS 60196

SERIAL NUMBER: 09438600
PATENT NUMBER:

FILING DATE: 11/12/1999
ISSUE DATE:

KIMBERLY WHITE, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

To The Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):
 Chan-Long Shieh
 Barbara Foley
 Huinan Yu
 Vi-En Choong

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

3. Nature of conveyance:

- ☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Other _____

Execution Date: 11/3/99

2. Name and address of receiving party(ies)

Name: Motorola, Inc.

Address: 1303 E. Algonquin Road

City: Schaumburg State: Illinois

Country: U.S.A. Zip: 60196

Additional name(s) & address(es) attached? ☐ Yes ☒ No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is: November 3, 1999

A. Patent Application No.(s)

Filing Date

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: John J. McDonnell

Registration No.: 26,949

Company Name: McDonnell, Boehnen, Hulbert & Berghoff

Street Address: 300 South Wacker Drive - 32nd Floor

City: Chicago State: Illinois

Country: U.S.A. ZIP: 60606

6. Total number of applications and patents involved: 1

7. Total Fee (37 CFR 3.41).....\$40.00

☒ Enclosed☐ Authorized to be charged to deposit account

8. Deposit account number:

13-2490

DO NOT USE THIS SPACE

11/26/1999 Statement and signature

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

John J. McDonnell

Printed Name of Person Signing

Signature

Date: November 12, 1999

Total number of pages including cover sheet, attachments, and document: 6

Mail documents to be recorded with required cover sheet information to:

Commissioner of Patents and Trademarks

Box Assignments

Washington, D.C. 20231

ASSIGNMENT

Case No.: 99,723
Inventors: Shieh, et al
Date of Execution
of Application:

Serial No.:

Filing Date:

In consideration of One Dollar (\$1.00) and other good and valuable considerations in hand paid, the receipt and sufficiency whereof are hereby acknowledged, the undersigned hereby assign to:

Motorola, Inc., 1303 East Algonquin Road, Schaumburg, IL 60196

its successors and assigns, the entire right, title and interest in the invention or improvements of the undersigned disclosed in an application for Letters Patent of the United States, entitled:

BIOCHANNEL ASSAY FOR HYBRIDIZATION WITH BIOMATERIAL

and identified as:

Case No. 99,723

in the offices of McDONNELL BOEHLEN HULBERT & BERGHOFF and in said application and any and all other applications, both United States and foreign, which the undersigned may file, either solely or jointly with others, on said invention or improvements, and in any and all Letters Patent of the United States and foreign countries, which may be obtained on any of said applications, and in any reissue or extension of such patents, and further assigns to said assignee the priority right provided by the International Convention.

The undersigned hereby authorize and request the Commissioner of Patents and Trademarks to issue said Letters Patent to said assignee.

The undersigned hereby authorize and request the attorneys of record in said application to insert in this assignment the filing date and serial number of said application when officially known, and the date of execution of the application.

The undersigned warrant themselves to be the owners of the entire right, title and interest in said invention or improvements and to have the right to make this assignment, and further warrant that there are no outstanding prior assignments, licenses, or other encumbrances on the interest herein assigned.

For said considerations the undersigned hereby agree, upon the request and at the expense of said assignee, its successors and assigns, to execute any and all divisional, continuation and substitute applications for said invention or improvements, and any necessary oath, affidavit or declaration relating thereto, and any application for the reissue or extension of any Letters Patent that may be granted upon said application and any and all applications and other documents for Letters Patent in foreign countries on said invention or improvements, that said assignee, its successors or assigns may deem necessary or expedient, and for the said considerations the undersigned authorize said assignee to apply for patents for said invention or improvements in its own name in such countries where such procedure is proper and further agree, upon the request of said assignee, its successors and assigns, to cooperate to the best of the ability of the undersigned with said assignee, its successors and assigns, in any proceedings or transactions involving such applications or patents, including the preparation and execution of preliminary statements, giving and producing evidence, and performing any and all other acts necessary to obtain, maintain and enforce said Letters Patent, both United States and foreign, and vest all rights therein hereby conveyed in the assignee, its successors and assigns, whereby said Letters Patent will be held and enjoyed by the said assignee, its successors and assigns, to the full end of the term for which said Letters Patent will be granted,

as fully and entirely as the same would have been held and enjoyed by the undersigned if this assignment had not been made.

WITNESS my hand and seal this 3rd day of November, 1999.

Chan Long Shieh
Chan-Long Shieh

State of Arizona

County of Maricopa

The foregoing instrument was acknowledged before me this 3rd day of

November, 1999 by CHAN-LONG SHIEH

Jeanine L. Thompson
NOTARY PUBLIC



Letters Patent will be granted, as fully and entirely as the same would have been held and enjoyed by the undersigned if this assignment had not been made.

WITNESS my hand and seal this 24th day of November, 1999.

Huinan Yu

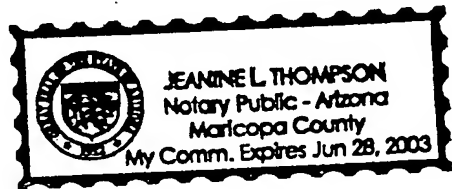
State of Arizona

County of Maricopa

The foregoing instrument was acknowledged before me this 24th day of

November, 1999 by Huinan Yu

Jeanine L. Thompson
NOTARY PUBLIC



Letters Patent will be granted, as fully and entirely as the same would have been held and enjoyed by the undersigned if this assignment had not been made.

WITNESS my hand and seal this 30th day of November, 1999.

Choong Vi-E
Vi-E Choong

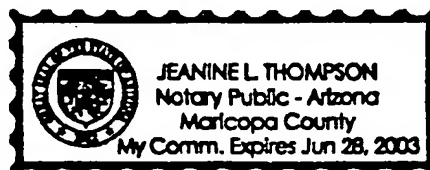
State of Arizona

County of Maricopa

The foregoing instrument was acknowledged before me this 30th day of

November, 1999 by VI-EN CHOONG

Jeanine L. Thompson
NOTARY PUBLIC



Letters Patent will be granted, as fully and entirely as the same would have been held and enjoyed by the undersigned if this assignment had not been made.

WITNESS my hand and seal this 5th day of November, 1999.

Barbara M. Foley
Barbara Foley

State of Arizona

County of Maricopa

The foregoing instrument was acknowledged before me this 5th day of

NOVEMBER, 1999 by BARBARA M. FOLEY

Jeanine L. Thompson
NOTARY PUBLIC

